

Remarks

Claims 1 through 5 are pending, claims 6 through 8 having been withdrawn by the Applicant's election dated September 8, 2004. The Examiner has rejected claims 1 through 5 under 35 USC 102(b) as being anticipated by US Patent 5,028,990 to Kotaki et al (hereinafter the '990 patent). By this response, none of the claims have been amended.

Claims 1 and 2

To anticipate a claim, a single reference must disclose each and every positively recited limitation. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Thus, in addition to the other recited features, for any purported reference to anticipate claims 1 and 2, it must also include first a patterning stop region disposed over the substrate such that all of the container bottom wall is defined by an upper surface of the patterning stop region, and second an insulating overlayer disposed over and in contact with the substrate.

The '990 patent neither teaches nor suggests such structure. Regarding the first of the two aforementioned features, the Examiner asserts at numbered paragraph 3 of the present Office Action that the '990 discloses "a patterning stop region 5b, fig 10 disposed over said substrate such that all of said container bottom wall is defined by an upper surface of said patterning stop region 5b". The Examiner's position is in clear conflict with what is shown in FIGS. 4b, 9 and 10 of the '990 patent, where there is no evidence of the entirety of a storage container bottom wall being defined by an upper surface of the patterning stop region 5b. Recourse to FIG. 10 shows that patterning stop region 5b defines, at most, less than half of the bottom wall of the container bottom wall. As such, it is impossible for the Examiner to reconcile the teaching of the '990 patent with the clear mandate of the claim, the nature of which is clearly shown in FIGS. 1D and 2 of the present invention, where (using FIG. 1D as an example) a patterning stop region 14 with an upper surface defines all of the container bottom wall 30. For this reason alone,

continued reliance on the '990 patent as a basis for an anticipatory rejection can no longer be justified.

Regarding the second of the two aforementioned features, the device of the '990 patent teaches multiple overlayers 6 and 8, neither of which individually satisfies the claimed requirement that the overlayer be in contact with the substrate, *and* that there is a container region within the insulating overlayer. The Applicant's position is bolstered by reference to FIGS. 4b, 9 and 10 of the '990 patent (the same figures relied on by the Examiner), where an insulating layer 6 is intermittently formed along the upper surface of substrate 1, while a separate insulating layer 8 includes a container region 9 disposed therein. The separate nature of the two overlayers is clear, as the first insulating overlayer 6 is neither made from the same material as that of insulating overlayer 8 nor contiguous with it. It is generally true in patent claim construction that a claim that uses "comprising" as a transition and subsequently identifies a singular indefinite article does not preclude the possibility of more than one of such article (see, e.g., *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 52 USPQ2d 1109, 1112 (Fed. Cir. 1999)). The courts have noted exceptions to this rule when the context of the claim within the supporting specification makes it clear that the indefinite article is limited to the singular. *Insituform Technologies, Inc. v. CAT Contracting, Inc.*, 40 USPQ2d 1602, 1608 (Fed. Cir. 1996).

To properly construe the coverage of the claim, it is imperative that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Miller*, 169 USPQ 597, 600 ((CCPA 1971), quoting *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). Using claim 1 as an example, the same clause that includes the recitation to "an" insulative overlayer disposed over the substrate also recites that the layer is "in contact with" the same substrate and further recites that the "insulating overlayer includ[es] a container region disposed therein". By force of logic, if "an" insulating overlayer is not limited to one, then it must also be true that EACH of the plurality of insulating overlayers must also be both in contact with the substrate and inclusive of a container region disposed therein, for these are clear

requirements of the same clause in the claim. Therefore, regardless of whether the present claims lend themselves to a singular or multiple interpretation of the insulating overlayer, the structural attributes of the one or more insulating overlayers in the allegedly anticipatory reference must still be consistent with the verbiage of the claim, lest the Examiner's rejection fail as a logical construct. Since the Examiner has not demonstrated that EACH of the multiple layers 6, 8 of the '990 patent (1) is in contact with the substrate AND (2) includes a container region formed therein, the Examiner's position is logically inconsistent, and therefore violative of the clear mandate of the claims. Accordingly, there can be no anticipatory rejection of independent claims 1 or 2.

Claims 3, 4 and 5

As stated above in conjunction with claims 1 and 2, a single reference must disclose each and every positively recited limitation to anticipate a claim. For claims 3, 4 and 5, the '990 patent must include the aforementioned insulating overlayer in contact with the substrate and forming a container region therein. Since the combined insulating overlayers 6, 8 of the '990 patent cannot individually satisfy this requirement for an insulative overlayer, there can be no anticipatory rejection of independent claims 3 or 4, or claim 5 that depends from claim 4.

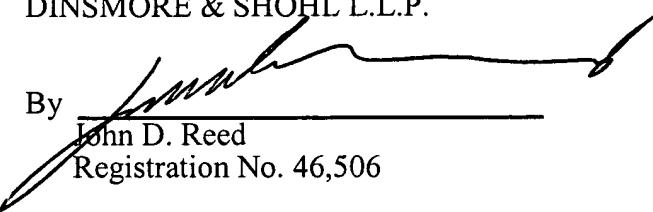
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Conclusion

Taken *in toto*, it is clear that the '990 patent does not teach the claimed device. As such, the Applicant respectfully submits that all of the claims are patentable over the cited art, and are entitled to a finding of allowability by the Examiner. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
DINSMORE & SHOHL L.L.P.

By


John D. Reed
Registration No. 46,506

One Dayton Centre
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
(937) 449-6453
Facsimile: (937) 449-6405